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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,142	01/16/2004	Henry Graf	4002-3469	7214

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP  
111 MONUMENT CIRCLE, SUITE 3700  
INDIANAPOLIS, IN 46204-5137

EXAMINER
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SAN MIGUEL, ANITZA M

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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06/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/760,142	GRAF, HENRY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anitza M. San Miguel	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on July 20, 2001. It is noted, however, that applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b).

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The disclosure is objected to because of the following informalities:

In page 6, paragraph 2, reference "18" refers both to "the internal surface" and "the walls" (page 4, paragraph 5).

In page 6, paragraph 4 and 6, reference "30" refers both to "the housing" and "the internal volume" (page 5, paragraph 2). However, reference "16" disclosed "the housing" (page 4, paragraph 5).

In page 7, paragraph 4, reference "16" refers both to "the internal volume" and "the housing" (page 4, paragraph 5). However, reference "16" disclosed "the housing" (page 4, paragraph 5).

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/330,722. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claims and the co-pending application claims lies in the fact that the co-pending application claims include more elements and are thus much specific. Thus the invention of the co-pending application claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the co-pending application claims, they are not patentably distinct from the co-pending application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

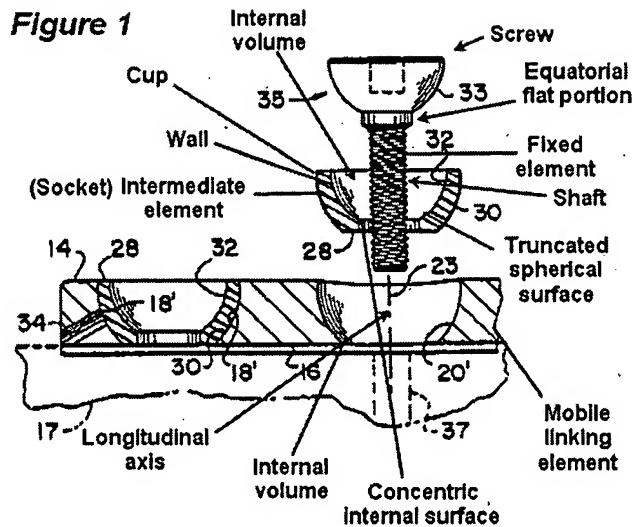
Claims 1-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (Reference U.S. Patent "5,057,111").

Park discloses an intervertebral linking device comprising: at least one fixed element (see Figure 1 below); at least one mobile linking element (see Figure 1 below); at least one intermediate element, wherein each intermediate element is received in an internal volume of a corresponding one of the at least one mobile linking element or of a corresponding one of the at least one fixed element, the intermediate element being deformable to be placed into the internal volume by impaction (see Figure 1 below and col. 3, lines 67-68 and col. 4, lines 1-5); and wherein the at least one fixed element or the at least one mobile linking element is received at least partially in an internal volume of the intermediate element having a mutual position of use with three degrees of freedom in rotation relative to the intermediate element while remaining linked in translation, and a mutual position of introduction in which the corresponding one of the at least one fixed element, or the corresponding one of the at least one mobile element, has three degrees of freedom in rotation and in translation relative to the intermediate element (see Figure 1 below). With regards to the three degrees of freedom in rotation relative to the intermediate element, the fixed element is capable of performing movement in three degrees of freedom. The fixed element may be capable of rotation in the x-y-z axis.

The intermediate element assumes the form of a cup (see Figure 1 below). The internal volume of the intermediate cup is bordered by a truncated spherical surface (col. 3, lines 10-13). The intermediate cup has a truncated spherical external surface,

which is concentric with the internal surface (see Figure 1 below). The internal and external surface defines a wall of the intermediate cup. The intermediate element is produced from polyethylene (col. 3, lines 67-68 and col. 4, lines 1-5).

Park further discloses the internal volume being at least part spherical having an internal diameter and an opening with a width smaller than said internal diameter, and wherein said intermediate element has an external diameter that is substantially the same as the internal diameter of said internal volume, such that when said intermediate element is inserted into said internal volume, said opening prevents said intermediate element from falling out of said internal volume (see Figure 1 below). The intermediate element (see Figure 1 below) has an internal volume having an internal diameter and an opening to said internal volume having a width less than said internal diameter, and said fixed element has a spherical head with an equatorial flat portion, said spherical head having a diameter between spherical surfaces that is substantially the same as said internal diameter, and said equatorial flat portion has a diameter that is substantially equal to said width of said opening (see Figure 1 below). The fixed element is a screw (first and second) having a shaft with a longitudinal axis, and said flat surfaces do not intersect said axis (see Figure 1 below). The linking member is separated from at least one of the bone by the at least one fixed element (see Figure 1 below).



### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park  
(Reference U.S. Patent "5,057,111").

Park discloses the claimed invention except for the thickness of the wall being from 1 to 1.5 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Park with the wall thickness being from 1 to 1.5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.



Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (Reference U.S. Patent "5,057,111") in view of Bryan (Reference U.S. Patent "5,306,275").

Park discloses the claimed invention except for the screw head having a hole in the equatorial flat portion, and further comprising a stop (set screw) inserted in said hole so that a portion of said stop extends above the equatorial flat portion. Bryan teaches to provide a screw with a head having a coaxial blind bore. Also, an anchor body with a nut (the combination thereof considered as a set screw) is received in the bore (col. 9, lines 20-57), in order to allow the screw to rotate about an axis thereby allowing the surgeon to orient the screw within the clamp in an infinite number of degrees of orientation. It would have been obvious for one ordinary skill in the art at the time the invention was made to construct the device of Park, in order to allow the screw to rotate about the axis thereby allowing the surgeon to orient the intermediate element and the mobile linking element in an infinite number of degrees of orientation.

### ***Response to Arguments***

Applicant's arguments filed March 29, 2007 have been fully considered but they are not persuasive. Applicant argues that the Park reference does not show or suggest a mobile linking element suitable for being displaced relative to fixed elements, nor an intermediate element that permits articulation of a mobile linking element relative to a fixed element. The examiner respectfully disagrees. The claims are directed to a device that is not attached to the bone. The applicant is "reading" the reference as it is attached

to the bone. The mobile linking element is capable being displaced relative to fixed elements, and the intermediate element is capable of permitting articulation of a mobile linking element relative to a fixed element if one desires to do so.

The statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Park, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is noted that the plate and the screw disclosed by Park are capable of being rotated in three degrees of freedom with respect to the intermediate member, for the above stated reasons.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anitza M. San Miguel whose telephone number is 571-272-3279. The examiner can normally be reached on 8:00 am - 5:30 pm EST (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASM



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